

### **Remarks**

Claims 1-31 are pending with claims 25 and 27-31 withdrawn. All pending claims except claim 17 stand rejected by the Examiner. Applicant thanks the Examiner for indicating the allowability of claim 17. In accordance with the express suggestions of Examiner, Applicant cancels claim 17 and adds new claim 32. Claim 32 presents original claim 17 in independent form.

Applicant also cancels claims 1-2 without prejudice and expressly reserves the right to pursue any canceled claims in one or more continuation or divisional applications.

New claim 33 incorporates the limitations of original claim 2 into previously presented claim 1 and addresses the Examiner's objection on the basis that the "outer tubular surface" lacks an antecedent basis. Therefore, claim 33 has the same scope as claim 2 but is written in independent form (see claims 1-2). Similarly, claims 3-11 (which depended from original claim 2) are unchanged in scope and therefore Applicant's intention is that no prosecution history estoppel applies to claims 3-11, 32 and 33. Please note that claims 3, 12-16 and 18-19 are amended to now depend from claim 33.

No new matter is entered through these amendments or the new claims.

### **Rejections under 35 U.S.C. § 102 based on Swanson**

Claims 1, 16 and 18 stand rejected as anticipated by Swanson. Applicant has canceled claim 1 and added claim 33. Claim 33 incorporates the lumen of claim 2 into previously presented claim 1. Therefore, claim 33 has exactly the same scope as previously presented claim 2 (see claims 1 and 2). Anticipation requires the teaching of each and every element in the cited reference. Swanson does not teach a lumen within the catheter shaft as required by Applicant's amended claim 33, and thus, for at least

this reason, Applicant submits that claims 33, 16 and 18 are not anticipated by Swanson.

**Rejections under 35 U.S.C. § 103(a) based on Bednarek**

**Claims 1-11, 13, 15, 19-23 and 26 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bednarek ('500) in view of Swanson and further in view of an alternate embodiment of Bednarek.**

Claim 1 also stands rejected as obvious over Bednarek ('500) in view of Swanson. Applicant previously argued that the previous obviousness rejection of the independent claim should be withdrawn because the cited embodiments did not disclose a braided electrode that was "interposed in a fixed position between the inner surface and the outer tubular surface." In response to this argument, the Examiner issued a new ground of rejection, citing an alternative embodiment of Bednarek:

The claim also differs from Bednarek in calling for the electrode to be in a fixed position. In an alternate embodiment, however, Bednarek teaches that the electrode may also be in a fixed position (col. 11, ln. 1-7 and Fig. 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have kept the electrode of Bednarek in a fixed position in view of an alternate embodiment of Bednarek as an obvious alternate way of using or constructing the device that is taught and suggested by the inventor.

(Office action at pg. 4).

Applicant respectfully points out that the even if you combine Swanson with the alternate embodiment of Bednarek, the combination does not yield the invention of claim 33. This argument is best illustrated by studying Fig. 6, the cited passage of Bednarek, and the cross-sectional Figures 12A and 12B of the document. Figure 12A and 12B are cross sectional portions of the alternate embodiment cited by the

Examiner. (Bednarek '500 at col. 5, ln. 1-6) (The brief description of Figures 12A and 12B makes clear that FIGS. 12A and 12B are "cross-section[s] of a ... portion of the ablation catheter of FIG. 6"). Figure 6 shows the outer surface of the electrode (118) in side view but the electrode itself obscures any view of the inner lumen. Thus, one must turn to Figures 12A and 12B to find the necessary clarity. As seen in Figure 12B, the electrode (118) is surrounded by an "outer tubular surface" as alleged by the Examiner. Clearly, however, there is no "inner surface" to sandwich the electrode. Figure 12A confirms that at more proximal positions as well, there is simply no "inner surface" in this embodiment which will permit the coil electrode to be interposed in a fixed relation.

More importantly, there is also no suggestion in the text or figures that the "inner surface" alleged by the Examiner (in Fig. 11) may be included in the alternate embodiment of Fig. 6. Indeed, the very passage cited by the Examiner explains why the alleged "inner surface" is not, and would not, be included in the alternative embodiment:

In an alternative preferred embodiment, ***instead of using an ablation catheter (20) advanced within a slotted sheath (22)***, [as was illustrated in Fig. 11] the rail catheter ablation and mapping system (100) may utilize an ablation catheter (110) . . . as shown in Fig. 6. (Bednarek '500 at col. 11, ln. 1-7).

When the electrode is placed in a fixed position as in the embodiment found in Figure 6, there is simply no need for the alleged "inner surface" catheter to advance the coil. In the embodiment of Figure 11, the ablation catheter 20 appears to include a inner tubular member upon which the coil is formed and it appears that the catheter is advanced within the slotted sheath by controlling the placement of the inner tubular member. In contrast, the ablation catheter shown in Fig. 6 does not slide, and therefore, there is no need to have an inner tubular member that slides. Therefore, the alleged "inner surface" is neither taught nor suggested in this embodiment. Furthermore, the addition of Swanson does nothing to remedy the lack of an inner surface in this embodiment. Because the inner surface is neither taught nor suggested

in the references cited, amended claim 33 is patentable over the cited references.  
Claim 26 is also patentable for at least the same reasons.

**Claim 12, 14 and 24 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bednarek ('500) in view of Swanson and further in view of Swartz.**

Claims 12 and 14 are amended to depend from new claim 33 and claim 24 is now amended to depend from claim 33. Claims 12, 14 and 24 are allowable for at least the same reason that claim 33 is allowable. Applicant requests that the rejections of amended claims 12, 14 and 14 based on obviousness be withdrawn.

**Rejections under 35 U.S.C. § 103(a) based on Sun and Swanson**

**Claim 1 and 18 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sun in view of Swanson.**

Applicant believes that the rejection of claims 1 and 18 based on the combination of Sun and Swanson was mistakenly included in the most recent Office action. The exact rejection (including every single word) was previously included on page 12 of the Office action of June 6, 2006 (prior to the amendment requiring the braided electrode interposed to be in "a fixed position between the inner surface and the outer tubular surface."). Because this rejection fails to consider the amended claim element, it is believed that its inclusion was a typographical mistake.

In any event, claim 33 is patentable over the combination of Sun and Swanson for at least two independent reasons: 1) the combination of cited references does not teach a braided electrode interposed in a **fixed position** between the inner surface and the outer tubular surface; and 2) the combination of cited references does not teach a catheter shaft defining an inner surface and an outer tubular surface, a lumen within the catheter shaft, and the outer tubular surface defining at least one braided electrode

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aperture such that a portion of the braided electrode is exposed, as required by claim 33. As such, the combination does not yield the claimed invention. Applicant respectfully submits that claim 33 is allowable over the combination of Sun and Swanson.

Applicant submits that the application is in condition for allowance. Timely notification of allowability is requested.

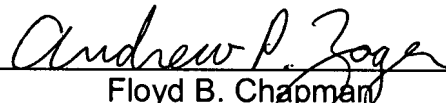
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No additional fees, requests for extension of time, other petitions, additional claim fees, or any other fees are believed to be necessary to enter and consider this paper. If, however, any extensions of time are required or any fees are due in order to enter or consider this paper or enter or consider any paper accompanying this paper, including fees for net addition of claims, Applicant hereby requests any extensions or petitions necessary and the Commissioner is hereby authorized to charge our Deposit Account No. 50-1129 for any fees. If there is any variance between the fee submitted and any fee required, or if the payment or fee payment information has been misplaced or is somehow insufficient to provide payment, the Commissioner is hereby authorized to charge or credit Deposit Account No. 50-1129.

Respectfully submitted,

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Date: April 23, 2007

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